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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,019	02/27/2004	Jochen Goerlitzer	DEAV2003/0017 US NP	8090
5487	7590	02/15/2006	EXAMINER	
ROSS J. OEHLER AVENTIS PHARMACEUTICALS INC. ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			ANDERSON, REBECCA L	
			ART UNIT	PAPER NUMBER
			1626	
DATE MAILED: 02/15/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/789,019

Applicant(s)

GOERLITZER ET AL.

Examiner

Rebecca L. Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2005 and 18 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>16 June 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-19 are currently pending in the instant application. Claims 13-19 are withdrawn from consideration as being for non-elected subject matter and claims 1-12 are rejected.

#### ***Response to Amendment and Arguments***

Applicants' amendment to the claims filed 18 November 2005 has overcome the objection to claims 2. Also the spelling of "resistance" and "sequelae" in withdrawn claims 13-19 has been corrected. Applicant amended the specification to include the claim to benefit of the US Provisional Application No. 60/494,911 along with the claim for foreign priority to DE 10208353.7 on 22 August 2005. As the product claims 1-12 are not allowable, claims 13-19 are still withdrawn from further consideration as they are drawn to a non-elected invention.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 22 August 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of a patent corresponding to USSN 10/789,281 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, the provisional obvious type double patenting rejection of claims 1-12 is overcome.

#### ***Priority***

Applicant cannot rely upon the foreign priority papers to overcome the following maintained rejection based on 35 USC 102(a), because an English translation of DE 10308353.7 has not been made of record in accordance with 37 CFR 1.55. See MPEP

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201.15. Specifically, while applicant filed a translation of DE 10308353.7 on 22 August 2005, applicant did not file the translation together with the required statement that the translation of the certified copy is accurate, see 37 CFR 1.55(a)(4)(i)-(ii). Therefore, the 35 USC 102(a) rejection is maintained.

***Maintained Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

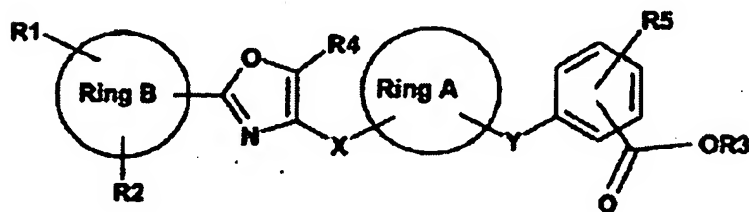
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1 - 12 are rejected under 35 U.S.C. §102(a) as being anticipated by German**

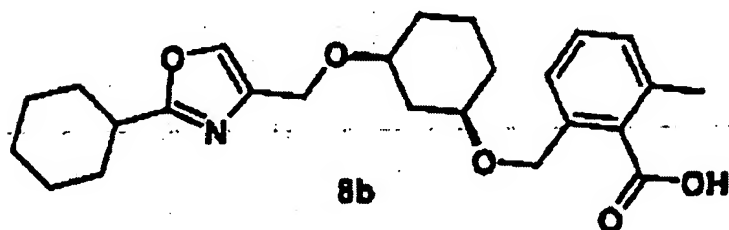
**Patent Application DE 101 42 734 A1, published March 27, 2003, to inventors H. Glombik, et al.**

Specifically, the present invention claims chemical compounds of formula (I),



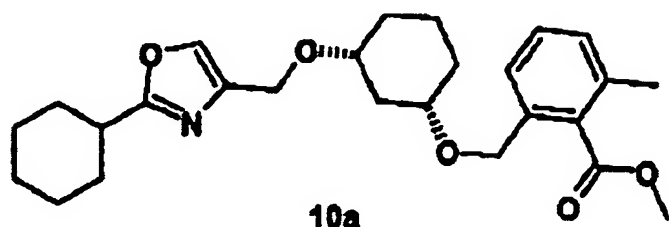
The prior art discloses compounds

with the following chemical structures:

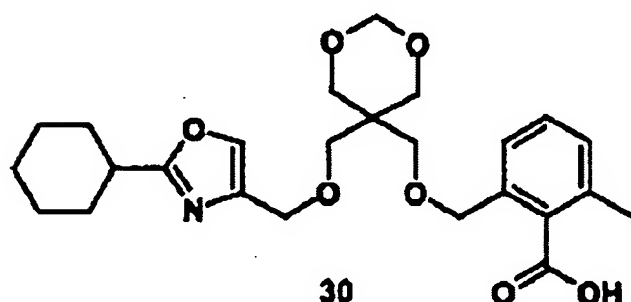


(Compound 8b, p. 11, lines 25 – 35);

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(Compound 10a, p. 11, lines 54 – 62);



and

(Compound 30, p. 18, lines 21 – 39).

Where the variables in formula (I) of the present invention are: (1) **Ring A** is cyclohexane; (2) **Ring B** is cyclohexane; (3)  $R^1 - R^5$  are each hydrogen; (4) **X** is  $CH_2-O$ ; and (5) **Y** is  $CH_2-O$ ; then the compounds of the present invention in **Claims 1, 2, 3, 4, 5, 6 and 7** are directly anticipated by “Compound 8b” and “Compound 10a” from the prior art, as drawn above.

Where the variables in formula (I) of the present invention are: (1) **Ring A** is 1,3-dioxane; (2) **Ring B** is cyclohexane; (3)  $R^1 - R^5$  are each hydrogen; (4) **X** is  $CH_2-O-CH_2$ ; and (5) **Y** is  $CH_2-O-CH_2$ ; then the compounds of the present invention in **Claims 1, 4 and 5** are directly anticipated by “Compound 30” from the prior art, as drawn above. [**Claims 2, 3, 6 and 7** limit **X** and/or **Y** to  $CH_2-O$  and are not anticipated by “Compound 30”].

**Claim 8** (pharmaceutical composition of claim 1 and a carrier) is anticipated by German Patent Application DE 101 42 734 at page 3, lines 30 – 57 and p. 24, lines 8 – 11.

**Claim 9** (pharmaceutical composition of claim 6 and at least one other active ingredient) is anticipated by German Patent Application DE 101 42 734 at p. 24, lines 9 – 10.

**Claim 10** (pharmaceutical composition where additional ingredient has favorable effects on metabolic disturbances) is anticipated by German Patent Application DE 101 42 734 at p. 7, lines 28 et seq.

**Claim 11** (pharmaceutical composition where additional ingredient is antidiabetic) is anticipated by German Patent Application DE 101 42 734 at p. 6, lines 18 – 22.

**Claim 12** (pharmaceutical composition where additional ingredient is lipid modulator) is anticipated by German Patent Application DE 101 42 734 at p. 6, lines 36 - 42.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.


The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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